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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,453	02/18/2004	Eric Jason Stelnicki	1027-2DIV	1761

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EXAMINER

SAFAVI, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/781,453	<b>Applicant(s)</b> STELNICKI, ERIC JASON	
	<b>Examiner</b> M. Safavi	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Nov. 02, 2005 & Feb. 02, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9, 18, 23, 26-28, 30, 32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) 30, 32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 18, 23, and 26-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

Applicant's election without traverse of the invention of Group I, claims 9, 18, 23, and 26-28, in the reply filed on February 02, 2006 is acknowledged.

Claims 30, 32, and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 02, 2006.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 18, 23, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihnat, Jr. '914 in view of any of El Hassen '367 or Steffen '133 or Simpson '109.**

Ihnat, Jr. teaches an apparatus comprising a headgear and at least one toroidal insert, cushion or support pad 28, (of soft conforming material [**claim 28**]), that is removably attachable to the headgear wherein the at least one insert is inserted into a pocket or receiver 24 within the headgear. Ihnat, Jr. does not appear to specifically disclose a rear protective cushion.

However, each of El Hassen, Steffen, and Simpson teach application and utilization of a cushion or support pad along the rear portion of a protective headgear, 2 of Fig. 1 of El Hassen, 18 of headgear 10 of Steffen, and any of the rear cushions shown by Simpson.

Therefore, to have formed the Ihnat, Jr. headgear with a rear insertion pocket so as to allow for removably attaching the support cushion pad 28 along a rear portion of a protective headgear, (including left rear or right rear, thus tangential to the side cushion pads, [claim 23]), so as to permit a user to add or change support cushion pad along the rear to protect the back of the users head, would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by any of El Hassen, Steffen, and Simpson with Simpson particularly teaching application of a toroidal support pad 19 of Fig. 4 which toroidal support pad may be applied at the rear of the headgear.

As concerns **claim 26**, any of the pads of Ihnat, Jr., as modified, thus a second support pad, is arranged to be stackable with at least one other second, or another, support pad for one of matching and exceeding the contour of the infant's head on a contra lateral side. The recitation "for controllably positioning and supporting a head of an infant while lying down" is a statement of intended use as is "the at least one rear support pad is arranged to be stackable with at least one other rear support pad for one of matching and exceeding the contour of the infant's head on a contra lateral side." A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art - if the prior art has the

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capability to so perform (see MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987). In the instant case, the headgear of Ihnat, Jr., as modified, is capable of positioning and supporting the head of an infant while lying down. And, the support pads of the modified Ihnat, Jr. headgear can be "stacked" in any fashion particularly, outside of the headgear. Or, one can stack any number of other cushions under any cushion of the modified Ihnat, Jr. headgear when a wearer is lying upon a surface.

As concerns **claim 27**, Ihnat, Jr., as modified, further discloses that the step of attaching the selected at least one support pad to the headgear includes inserting the selected at least one support pad into a pocket on the headgear.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ihnat, Jr. '914 in view of any of El Hassen '367 or Steffen '133 or Simpson '109 as applied to claims 18, 23 and 26-28 above, and further in view of Bridley '832.**

Bridley discloses an infant positioning system comprising an infant support device (10) configured for receiving the infant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided or coupled the modified Ihnat, Jr. cap with the support device positioning system of Bridley, so as to allow for protection of the infant's head during sleep.

**Claims 18, 23, 26 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over El Hassen '367 in view of Clavelle '840 and either of Simpson '109 or Ihnat, Jr. '914.**

El Hassen discloses a cap provided with support pads 2, (of soft conforming material [**claim 28**]), including a rear support pad. The padded parts may be fastened to the band by any means, col. 2, lines 38-41. El Hassen does not appear to specifically disclose the support pads as removable nor does El Hassen appear to specifically disclose the support pads as toroidal.

However, Clavelle teaches removably fastening auxiliary parts to a cap as by hook and loop fasteners, snaps, etc. And, each of Simpson '109 and Ihnat, Jr. '914 teach utilization of a toroidal cushion member within and about a cap to cushion or protect the wearer's head.

Therefore, to have attached the pads of El Hassen in a removable fashion as by hook and loop fastening means, thus permitting a user to wash or change support cushion pads, as well as utilize toroidal cushioning members as one or any number of the padded parts would have been obvious to one having ordinary skill in the art at the time the invention was made as taught by Clavelle and either of Simpson '109 and Ihnat, Jr. '914.

As concerns **claim 26**, any of the pads of El Hassen, as modified, thus a second support pad, is arranged to be stackable with at least one other second, or another, support pad for one of matching and exceeding the contour of the infant's head on a contra lateral side. The recitation "for controllably positioning and supporting a head of an infant while lying down" is a statement of intended use as is "the at least one rear support pad is arranged to be stackable with at least one other rear support pad for one of matching and exceeding the contour of the infant's head on a contra lateral side." A

recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art - if the prior art has the capability to so perform (see MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647 (1987)). In the instant case, the headgear of El Hassen, as modified, is capable of positioning and supporting the head of an infant while lying down. And, the support pads of the modified El Hassen headgear can be "stacked" in any fashion particularly, outside of the headgear. Or, one can stack any number of other cushions under any cushion of the modified El Hassen headgear when a wearer is lying upon a surface.

### ***Response to Arguments***

Applicant's arguments filed November 02, 2005 have been fully considered but they are not persuasive. As for Applicant's argument bridging pages 6 and 7 of the response, each of Ihnat, Jr. '914, El Hassen '367, Steffen '133 and Simpson '109 are directed to headwear with a concern for safety and protection of the head. As such, the applied art to Ihnat, Jr. '914, El Hassen '367, Steffen '133 and Simpson '109 falls within the scope of the instant invention. And each of each of Ihnat, Jr. '914, El Hassen '367, Steffen '133 and Simpson '109 teach "support characteristics". Examiner invites Applicant to clearly explain how each or any of Ihnat, Jr. '914, El Hassen '367, Steffen '133 and Simpson '109 do not provide for "support characteristics".

As for Applicant's argument bridging pages 7 and 8 of the response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the headwear art would have taken the explicit protective headwear teachings of any of El Hassen '367, Steffen '133 and Simpson '109 to add a rear support, (including toroidal support), to the rear of the protective headwear teaching of Ihnat, Jr. '914 to further the protective area and protective capacity of the Ihnat, Jr. '914 headwear. Further, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

With regard to Applicant's argument within the second full paragraph on page 9 of the response, the proposed rejection involving Ihnat, Jr. '914 in view of any of El Hassen '367 or Steffen '133 or Simpson '109 does not "move the cushions to the rear of the head". Rather, the proposed rejection adds a cushion to the rear of the Ihnat, Jr. '914 headwear while maintaining the cushions along the side portions hereof. Applicant's extraction of the various teachings of each of El Hassen '367 or Steffen '133 or Simpson '109 have been noted. However, the teachings of each of El Hassen '367 or Steffen '133 or Simpson '109 taken as a whole do not preclude a modification of Ihnat, Jr. '914.



Applicant's argument from the bottom of page 10 to the middle of page 11 of the response appears directed to Examiner's modification and motivation for the previously applied rejection specifically directed to withdrawn claims 30 and 34 and thus, are considered moot. Otherwise, reference is made to the above remarks with respect to Ihnat, Jr. '914 in view of any of El Hassen '367 or Steffen '133 or Simpson '109.

As for Applicant's argument bridging pages 12 and 13 of the response, the instantly proposed rejection involving Clavelle '840 does not provide or "combine a heat shield with impact protection headgear". Rather, Clavelle has been utilized to teach removably fastening auxiliary parts to a cap as by hook and loop fasteners, snaps, etc. And, it is not at all seen why "[positioning] a toroidal cushion about the rear of the headgear would undermine the very goal which El Hassen, Simpson, and Ihnat, Jr. are focused on achieving", particularly with either of Simpson, and Ihnat Jr. teaching utilization of toroidal cushion, (rear or otherwise), to realize protection from injury.

Applicant's argument within the first full paragraph on page 13 of the response appears directed to Examiner's modification and motivation for the previously applied rejection specifically directed to withdrawn claim 30 and thus, are considered moot.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on (571) 272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. Safavi  
April 10, 2006

**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 3673**